

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: W. Grell et al) Art Unit: 1611

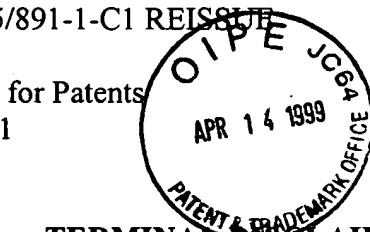
Serial No.: 08/946,602) Examiner: R.L. Raymond

Filed: October 7, 1997)

For: PHENYLACETIC ACID BENZYLAMIDES

Attorney Docket No.: 5/891-1-C1 REISSUE

Assistant Commissioner for Patents
Washington, D.C. 20231



TERMINAL DISCLAIMER
PURSUANT TO 37 CFR 1.321 (b)

Sir:

I, Mary-Ellen M. Devlin, represent that I am an attorney of record in and for United States Patent Application Serial No. 08/946,602, filed on October 7, 1997, for the invention entitled "PHENYLACETIC ACID BENZYLAMIDES".

Pursuant to 37 CFR 1.321 (b), I hereby disclaim the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of United States Patent No. 4,863,724, i.e., September 5, 2006, and hereby agree that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to United States Patent No. 4,863,724, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

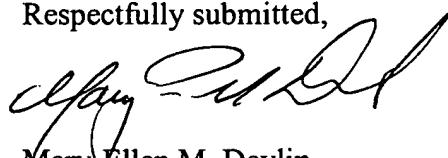
By virtue of an assignment recorded in the United States Patent and Trademark Office on July 12, 1989, at Reel No. 5132 and Frame No. 0174, in connection with U.S. Pat. No. 4,863,724, and by virtue by assignments recorded in the United States Patent and Trademark Office on February 1, 1993, at Reel No. 6404 and Frame No. 0637, and on December 20, 1993, at Reel No. 6811 and Frame No. 0584, in connection with U.S. Pat. No. 5,216,167, legal title to both United States Patent No. 4,863,724 and any

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patent to be granted on the above-identified application are currently vested in Dr. Karl Thomae GmbH, Biberach an der Riss.

The fee set forth in 37 CFR 1.20(d) for the filing of this statutory terminal disclaimer is \$110.00. The Commissioner is authorized to charge this fee, and any other fee due for the consideration of the above-captioned application, to Deposit Account No. 02-2955.

Respectfully submitted,



Mary-Ellen M. Devlin
Reg. No. 27,928

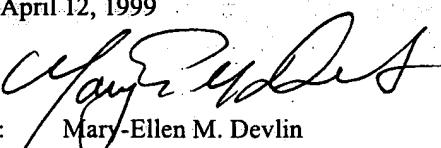
April 12, 1999

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
Ridgefield, CT 06877
Tel: 203-798-4866
Case 5/891-1-C1 REISSUE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, DC 20231

on April 12, 1999

By: 
Mary-Ellen M. Devlin
Reg. No. 27,928

SUBJECT: DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

DATE: 4-29-99

APPL. S.N.: 081946,602

TO EXAMINER: R. Raymond

ART UNIT: 1611

M. MINTGOMERY ROOM 18

MAILROOM DATE 4-14-99

AFTER FINAL YES NO NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE IN LEFT IN FILE.

The T.D. is PROPER and has been recorded. (See 14.23).

The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

Application Examiner has not processed T.D. fee. (See fee authorization).

The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

The person who signed the terminal disclaimer:

has failed to state his/her capacity to sign for the business entity. (See 14.28).

is not recognized as an officer of the assignee. (See 14.29 and possibly 14.29.01).

No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

Other: _____

Suggestion to request refund of \$ _____. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALITIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

- Sample of a TD over a pending application and assignee Certificate (See 14.37).
- Sample of a TD over a prior patent and assignee Certificate (See 14.38).
- Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)